

REMARKS

Claims 1-47 are pending. By this Amendment, claims 1-4, 7, 11-14, 16-23, 28-32, 36, 37, 39, 42-44, 46 and 47 are amended. The independent claims are amended to even more clearly distinguish over the applied references. In addition, obvious typographical informalities have been corrected. No new matter is added by the above amendments.

Applicant notes with appreciation the identification of allowable subject matter in claims 9 and 11. Applicant submits that all pending claims are in condition for allowance as detailed below.

Claims 1-6 and 12-47 stand rejected under 35 U.S.C. §102(b) over U.S. Patent No. 6,017,157 to Garfinkle et al. This rejection is respectfully traversed.

Garfinkle et al. does not disclose or suggest the combinations of features recited in the independent claims of this application. Garfinkle et al. discloses a method of processing digital images and distributing prints produced from the digital images. Garfinkle et al. discloses that a photographer 8 sends images to a location such as a developer or a scanning station (for example, by sending film or by transmitting digital images). See col. 2, lines 53-64. Authorized access to the digital images then is permissible using an access code. See col. 1, lines 65-67, col. 2, lines 65-67 and col. 4, lines 55-67. The photographer 8 can then access the digital images and order and receive prints. See, for example, col. 1, line 67 - col. 2, line 4, col. 2, line 67 - col. 3, line 3, col. 5, lines 20-29 and col. 7, lines 12-16.

Garfinkle et al. indicates that the "photographer" can be anyone who has access to the digital images, and is not necessarily the person who took the pictures. See col. 3, lines 9-12. However, Garfinkle et al. clearly discloses that the billing information for providing the prints is provided by the "photographer" when the "photographer" places an order for the prints (see col. 9, lines 26-32), and that the entity ("photographer") placing the order is the entity that is

billed (i.e., the credit card number of the "photographer" placing the order is used). See col. 9, lines 38-41.

With respect to independent claim 1, Garfinkle et al. does not disclose or suggest a method in which a viewer orders prints of a digital image that has been registered by a registrant, and the print charge for printing the digital image is charged to the registrant (not the viewer who orders the prints) "even when the viewer which placed the order ... is a different entity than the registrant." As noted above, Garfinkle et al. teaches that the entity (referred to as the photographer 8) that places the order is billed for the prints. Thus, Garfinkle et al. does not disclose or suggest a method in which the registrant of the digital image is billed for print charges incurred by a viewer that is a different entity than the registrant.

Similarly, with respect to independent claim 22, Garfinkle et al. does not disclose or suggest an apparatus that permits a registrant to input digital images, a viewer to order a print of a viewed digital image, and that outputs data for billing the print charge to the registrant "even when the viewer which placed the order is a different entity than the registrant." As discussed above with respect to independent claim 1, Garfinkle et al. always bills the entity that ordered the prints.

With respect to independent claim 17, Garfinkle et al. does not disclose or suggest a method in which orders that have been accepted from a plurality of different viewers for printing a digital image are summed within a predetermined period, and then the prints are produced based on such summing. While Garfinkle et al., as pointed out in the Office Action, keeps digital images available for ordering for a set time period, Garfinkle et al. processes each order for prints after that order is made. Thus, Garfinkle et al. does not disclose or suggest summing orders that have been accepted within a predetermined time period, and then producing prints based on such summing.

Independent claims 23, 32, 36, 37, 43 and 44 all relate to methods and apparatus in which a purchaser of a product of digital contents sold by a registrant can obtain a print of an image that has been registered by the registrant in relation to the product of digital contents. For example, and as explained in the specification, a purchaser of a product of digital contents (for example, music, movies or software games) purchases that product, and then can obtain an image that relates to that product (for example, a label that can be placed on a recording medium on which the purchaser stores the digital contents, the label containing information about the product (for example, the name of the artist, etc.)). Garfinkle et al. does not disclose or suggest any such method or apparatus. Garfinkle et al. merely processes images that have been taken by a photographer. While Garfinkle et al. indicates that the photographer can order products on which the print of the image is placed (for example, mugs or t-shirts), such products are not products of digital contents.

With respect to independent claim 23, Garfinkle et al. does not disclose or suggest any of the three recited steps. Garfinkle et al. does not disclose a first step of receiving information of an image in relation to a product of digital contents, a second step of producing a print of the image that relates to the product of digital contents that has been purchased by a purchaser, and does not disclose or suggest the third step of billing the print charge for that second step to the registrant, wherein the purchaser is a different entity than the registrant.

With respect to independent claim 32, Garfinkle et al. does not disclose or suggest the first step of accepting a contact from a purchaser of a product of digital contents who has obtained an authorization through the purchase of the product of digital contents from a registrant. Garfinkle et al. also does not disclose or suggest the claimed second step of producing a print of an image related to the product of digital contents based on the authorization, or the third step of billing the print charges to the registrant, wherein the purchaser is a different entity than the registrant.

With respect to independent claim 36, Garfinkle et al. does not disclose or suggest an apparatus having an input that receives information of an image associated with digital contents that has been purchased by a purchaser, and a billing data output that outputs data for billing the print charge for printing the image to the registrant, wherein the purchaser is a different entity than the registrant.

With respect to independent claim 37, Garfinkle et al. does not disclose the claimed first step of selling a product of digital contents to a purchaser, and the claimed second step of outputting information relating to the image that relates to the product of digital contents that was sold to the purchaser for the purpose of producing a print of the image.

With respect to independent claim 43, Garfinkle et al. does not disclose or suggest an apparatus that sells a product of digital contents to a purchaser. Garfinkle et al. also does not disclose or suggest structure for inputting information for delivery of a print of the image that relates to the product of digital contents, or the claimed information output that outputs (i) information of the image relating to the product of digital contents that was sold to the purchaser, and (ii) the information for delivery of the print.

With respect to independent claim 44, Garfinkle et al. does not disclose or suggest a method in which a registrant sells a product of digital contents to a purchaser, a printer receives information relating to the image that was registered relating to the product of digital contents that was sold to the purchaser, the third step of producing a print, and the fourth step of billing the print charge to the registrant, wherein the purchaser is a different entity than the registrant.

Accordingly, Applicant respectfully submits that all independent claims, as well as the claims which depend therefrom, are patentable over Garfinkle et al.

Claims 7 and 10 stand rejected under 35 U.S.C. §103(a) over Garfinkle et al. in view of U.S. Patent No. 6,714,314 to Ueda. In addition, claim 8 stands rejected under 35 U.S.C. §103(a) over Garfinkle et al. in view of Ueda, and further in view of U.S. Patent No. 6,516,157

to Maruta et al. As Ueda and Maruta et al. do not overcome the deficiencies noted above with respect to independent claim 1, claims 7, 8 and 10 are patentable for at least the reasons set forth above with respect to their corresponding independent claim 1.

In view of the foregoing, Applicant respectfully submits that this application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further would be desirable to place this application in even better condition for allowance, the Examiner is invited to contact Applicant's undersigned attorney at the telephone number set forth below.

Respectfully submitted,



Mario A. Costantino
Registration No. 33,565

MAC/jth

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OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

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